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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,338	06/18/2001	Sohei Kanno	209861US0PCT	8914

22850 7590 10/02/2003

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EXAMINER

BASI, NIRMAL SINGH

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 10/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/868,338

Applicant(s)
Kanno et al

Examiner
Nirmal S. Basi

Art Unit
1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 18, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1646

DETAILED ACTION

Election/Restrictions

1 Restriction is required under 35 U.S.C. 121 and 372.

5 This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

 In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

10 Group I. Claims 1, 2, 3, 4, 13 and 14 drawn to protein comprising the amino acid sequence of SEQ ID NO:8, DNA encoding the protein comprising the amino acid sequence of SEQ ID NO:8 and DNA comprising a nucleotide sequence coding for a fusion protein having the amino acid sequence of SEQ ID NO:8, SEQ ID NO:9, and SEQ ID NO:10.

15 Group II. Claims 5, 6, 7,8 drawn to protein comprising the amino acid sequence of SEQ ID NO:9, DNA encoding the protein comprising the amino acid sequence of SEQ ID NO:9,

 Group III. Claims 9, 10, 11, 12 drawn to protein comprising the amino acid sequence of SEQ ID NO:10, DNA encoding the protein comprising the amino acid sequence of SEQ ID NO:10,

20

Art Unit: 1646

The inventions listed as Groups I - III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding technical feature for the following reasons. Group I is drawn to protein comprising the amino acid sequence of SEQ ID NO:8, DNA encoding the protein comprising the amino acid sequence of SEQ ID NO:8 and DNA comprising a nucleotide sequence coding for a fusion protein having the amino acid sequence of SEQ ID NO:8, SEQ ID NO:9, and SEQ ID NO:10. The special technical feature of Group I is the protein disclosed in SEQ ID NO:8. The claims of Group I-III are drawn to a multitude of nucleic acids, encoding distinct proteins. The claims of Groups II and III apply to structurally and functionally different nucleic acids and their encoded proteins which do not necessarily contain the protein disclosed in SEQ ID NO:8 (Group I) or its encoding nucleic acid. Each of the nucleic acids/proteins of Groups I-III are independent and distinct because they have different functional properties and are structurally different. Accordingly, these claims are subject to restriction under U.S.C. § 121. The claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept. Since no technical feature in any group, other than the main invention, is shared by any other invention, unity of invention is lacking.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1646

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

2. Preliminary Amendments filed 6/18/02 (paper number 5), has been entered.

The amendment filed 6/18/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The Amendment to replace the paragraph on page 9, line 24, through 10, line 26 introduces the new matter of "60%". Applicant has replaced 40% with "60%". Applicant has justified the amendment by stating that, "support for the amendment is found, for example, on page 10, lines 12-26". Examiner fails to find said support for the amendment. If the examiners rejection is in error then Applicant is advised to specifically disclose how the "40%", contained in the specification as filed, is supported by specification on page 10, lines 12-26". A mere statement that "support for the amendment is found, for example, on page 10, lines 12-26", is not enough, Applicant must disclose the specific support.

Applicant is required to cancel the new matter in the reply to this Office Action.

Art Unit: 1646

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Nirmal S. Basi
Art Unit 1646
September 29, 2003

Michael D. Pak
MICHAEL PAK
PRIMARY EXAMINER